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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,816	01/22/2004	William J. Shaw	10527-455001	6207

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FISH & RICHARDSON PC  
P.O. BOX 1022  
MINNEAPOLIS, MN 55440-1022

EXAMINER
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STEWART, ALVIN J

ART UNIT	PAPER NUMBER
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3774

NOTIFICATION DATE	DELIVERY MODE
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06/04/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/762,816	<b>Applicant(s)</b> SHAW, WILLIAM J.	
	<b>Examiner</b> Alvin J. Stewart	<b>Art Unit</b> 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03/06/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-25 and 33-40 is/are pending in the application.
- 4a) Of the above claim(s) 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-25, 33 and 35-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 33, 39 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Radisch, Jr. et al US Patent Pub. 2005/0149102 A1.

Radisch, Jr. et al discloses a medical device having a tubular structure (26) and a polymer element (see claim 1) on the tubular structure (see Figs. 2 and 5), wherein the polymer element comprises a ceramic fiber (see claim 9) comprising a metalloid (see boron in claim 9) and the fiber is greater than one micron.

NOTE: claim 9 discloses that the fibers of ceramic can be mixed with a metalloid (boron).

Regarding claims 39 and 40, see paragraph 40.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Litner US Patent 6,589,286 B1.

Litner discloses a tubular structure (10) comprising at least two fibers, the first fiber being a ceramic fiber and a second fiber made of metal, wherein the ceramic fiber is intertwined with the non-ceramic fiber and the device is in the form of a stent (see col. 5, lines 18-26). However, Litner does not disclose a metal made of stainless steel or Nitinol.

NOTE: the prior art specification clearly disclose that the fibers can be combined with different materials, such as, ceramic materials and metal materials, see col. 5, lines 19-21.

Regarding the phrase “greater than one micron” see col. 5, lines 22-24 disclosing a diameter larger than 1 micron.

Regarding claims 23-25, see col. 5, lines 24-25 and 36-40.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the metal of the Litner reference with a metal made of stainless steel and/or Nitinol because Applicant has not disclosed that by having a stainless steel or Nitinol provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the biocompatible metal of the Litner reference because it would perform equally as well.

Therefore, it would have been an obvious matter of design choice to modify the Litner reference to obtain the invention as specified in claim 1.

***Claim Rejections - 35 USC § 103***

Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radisch, Jr. et al US Patent Pub. 2005/0149102 A1 in view of Sperk, Jr. et al US Patent 5,258,445.

Radisch, Jr. et al discloses the invention substantially as claimed. However, Radisch, Jr. et al does not disclose fibers from about 10 microns to 1,000 microns long and about ten microns wide.

Sperk, Jr. et al teaches reinforcing fibers located within a polymer matrix having fibers lengths from 10 microns to about 1,000 microns long and fibers having fibers about 10 microns wide (see col. 17, lines 28-31 and 48-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the fiber of the Radisch, Jr. et al with the fibers of the Sperk, Jr. et al in order to increase the strength of the polymeric material.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached Monday through Thursday and every other Friday from 9:00am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Isabella can be reached at 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Art Unit: 3774

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

06/01/09

/Alvin J Stewart/

Primary Examiner, Art Unit 3774